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Claims 5 and 7 have been amended. Claims 6 and 9 have been cancelled. New claims 16–20 have been added. A clean version of the amended and new claims is attached at Tab 1. A marked-up version of the amended and new claims is attached at Tab 2. Claim 9 has been amended and rewritten in independent form in the form of new claim 16. Claims 7, 9 and 10 have been amended to correct inadvertent clerical errors, to provide proper dependency, and not for reasons related to patentability. Support for the amendments to claims 5 and new claims 16–20 can be found in general throughout Applicants' Specification and in particular, for example, as follows: claim 5, page 10, lines 16–24, claim 16, original claim 9, claim 17 page 8, line 11–page 9, line 2, claims 18 and 19, page 10, lines 16–24, page 3, lines 3–14 and page 13, lines 11–22, claim 20, original claims 11 and 12 and page 3, lines 3–14 and page 13, lines 11–22.

Claims 5, 7 and 10 stand rejected under 35 U.S.C. § 112, second paragraph. Applicants submit that claim 5, which now recites “the (meth)acrylamide comonomer has no dissociable proton having a  $K_d$  of greater than  $10^{-3}$ ,” satisfies the criteria of 35 U.S.C. § 112, second paragraph. Applicants further submit that claims 7, 16 (formerly claim 9) and 10, which now indicate that the polymeric stabilizer is the optional component, satisfy the criteria of 35 U.S.C. § 112, second paragraph. In light of the above, Applicants request that the rejection of claims 5, 7, 10 and 16 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claim 11 stands rejected under 35 U.S.C. § 112, first paragraph. Applicants respectfully traverse this rejection. Applicants' Specification describes preparing microsphere adhesives that include microspheres formulated with (meth)acrylamide containing comonomer (“in situ”) (see, e.g., page 2, lines 15–28 and page 4, line 24–page 7, line 6). Applicants direct the Examiner's attention to pages three and thirteen of Applicants' Specification wherein reference is made to a series of patents at least one of which, US 5,045,569 (Delgado), discloses microsphere adhesives in which a majority of the microspheres contain at least one interior void having a diameter that is at least about 10 % of the diameter of the microsphere, and methods of making the same. U.S. 5,045,569 (Delgado) is incorporated by reference into Applicants' Specification. Thus, Applicants' Specification enables the skilled artisan to make the microsphere adhesive

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disclosed in claim 11. Applicants submit, therefore, that the rejection of claim 11 under 35 U.S.C. § 112, first paragraph, is unwarranted and request that it be withdrawn.

Claim 5 stands rejected under 35 U.S.C. §§ 102(b) and 103 over Cooprider et al. (U.S. 5,571,617).

Applicants submit that the amendment to claim 5, which now recites, "a polymeric stabilizer selected from the group consisting of carboxy modified polyacrylamides, polymeric quaternary amines, cellulosic, carboxy-modified cellulose and combinations thereof" renders moot the rejections of claim 5 under 35 U.S.C. §§ 102(b) and 103 over Cooprider et al., and request that they be withdrawn.

Claims 7 and 16 stand rejected under 35 U.S.C. § 103 over Cooprider et al.

Cooprider et al. disclose a coated sheet that includes a backing and a coating of repositionable pressure-sensitive adhesive disposed on the backing. The repositionable adhesive includes solid microspheres, polymeric stabilizer and surfactant.

Claim 7 is directed to an adhesive coated article that includes a microsphere adhesive that includes a chain transfer agent in an amount sufficient to produce 30-98 % of a solvent-soluble portion in the microspheres. To establish a prima facie case of obviousness all of the claim limitations must be taught or suggested by the prior art. M.P.E.P. 2143.03 *citing In re Royka*, 490 F.2d 981 (CCPA 1974); see also, B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 U.S.P.Q.2D (BNA) 1314, 1318 (Fed. Cir. 1996) (To establish a prima facie case of obviousness based on a single reference there must be some teaching, suggestion or motivation to modify the teachings of that reference). The teaching, suggestion or motivation must be found in the prior art and must not be based on Applicants' disclosure. See M.P.E.P. 2142. It is undisputed that Cooprider et al. fail to teach a chain transfer agent. Cooprider et al. thus lack a required element of claim 7, i.e., a chain transfer agent. Cooprider et al. also fail to suggest a chain transfer agent. Nothing in Cooprider et al. provides the skilled artisan with the requisite motivation for including a chain transfer agent in the composition of Cooprider et al. Accordingly, the skilled artisan would have no reason to sua sponte modify the composition of Cooprider et al. to achieve the article of claim 7. Applicants submit, therefore, that a prima facie case of obviousness has not been established. Accordingly, the rejection of claim 7 under 35 U.S.C. § 103 over Cooprider et al. cannot

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stand and must be withdrawn. Should the rejection be maintained, Applicants respectfully request that the Office action identify, by column and line number, the location in Cooprider et al. that provides the requisite suggestion or motivation to modify the microsphere adhesive of Cooprider et al.

Applicants hereby record their objection to and disagreement with the statements in the Office action that imply that chain transfer agents are conventional additives and that the chain transfer agent may well decompose during processing (see, September 12, 2002 Office action, page 5). To the extent such statements are reiterated in a subsequent Office action on the above-captioned application, Applicants request that the Office action contain a basis in fact or technical reasoning in support of these statements.

Claim 16, formerly claim 9, which includes a chain transfer agent, is distinguishable under 35 U.S.C. § 103 over Cooprider et al. for at least the same reasons set forth above in distinguishing claim 7.

Claims 8 and 10 stand rejected under 35 U.S.C. § 103 over Cooprider et al. in view of LeFevre. Claims 8 and 10 are dependent upon claims 7 and 16, respectively. The secondary reference of LeFevre does not cure the deficiencies of Cooprider et al. that are set forth above. Accordingly, claims 8 and 10 are patentable under 35 U.S.C. § 103 over Cooprider et al. in view of LeFevre for at least the same reasons set forth above in distinguishing claim 7.

Claim 11 stands rejected under 35 U.S.C. § 103 over Delgado (U.S. 4,988,567).

Delgado discloses a pressure-sensitive adhesive that includes hollow, polymeric, acrylate, inherently tacky, infusible, solvent-insoluble, solvent-dispersible, elastomeric, nitrogen-containing, acid-free microspheres that include at least about 70 parts by weight of at least one alkyl acrylate or alkyl methacrylate ester, and up to about 30 parts by weight of at least one nitrogen-containing polar monomer. A majority of the microspheres has multiple interior voids. A majority of the voids have a diameter of less than about 10 % of the diameter of the microspheres. The total of all void diameters is at least about 10 % of the diameter of the microsphere.

Claim 11 is directed to an adhesive coated article that includes a microsphere adhesive that includes a number of hollow, polymeric, acrylate, inherently tacky, infusible, solvent-insoluble, solvent dispersible, pressure sensitive microspheres that

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include at least about 85 parts by weight of at least one alkyl acrylate ester or alkyl methacrylate ester, and up to about 15 parts by weight of at least one (meth)acrylamide monomer. A majority of the microspheres contains at least one interior void having a diameter at least about 10 % of the diameter of the hollow microspheres. Delgado does not teach microspheres that include (meth)acrylamide monomer. Example 11 of Delgado, which is referenced by the Office action, does not support a finding to the contrary. The microspheres of Example 11 include octylacrylamide. Octylacrylamide is not (meth)acrylamide.

Delgado also does not teach or suggest a microsphere adhesive in which a majority of the microspheres includes at least one interior void in the microsphere has a diameter that is at least about 10 % of the diameter of the hollow microsphere. Instead, Delgado discloses that a majority of the microspheres includes multiple interior voids and a majority of those voids have a diameter that is less than about 10 % of the diameter of the microsphere. In addition, nothing in Delgado provides the skilled artisan with the requisite motivation to modify the microsphere adhesive of Delgado such that a majority of the microspheres of the adhesive has at least one interior void having a diameter that is at least about 10 % of the diameter of the microsphere. Moreover, the skilled artisan would not think to modify the adhesive of Delgado to include a majority of microspheres having at least one interior void having a diameter that is at least about 10 % of the diameter of the microsphere because Delgado teaches that each of the voids should be less than about 10 % of the diameter of the microsphere. Delgado thus fails to teach or suggest required elements of the article of claim 11. Therefore, a prima facie case of obviousness has not been established. Applicants submit that the rejection of claim 11 under 35 U.S.C. § 103 over Delgado is not sound and request that it be withdrawn.

Applicants note that the rejection of claim 11 under 35 U.S.C. § 103 appears to be based, in part, on inherency (see, September 12<sup>th</sup> Office action, page 6). Nothing in the record establishes that the property alleged to be inherent in the Delgado microspheres actually is present therein, and nothing in the record establishes that the alleged inherent property was known. It is well established that an obviousness rejection cannot be predicated on that which is unknown. In re Spormann, 53 C.C.P.A. 1375, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Accordingly, an obviousness rejection cannot

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be based on inherency. Applicants submit, therefore, that to the extent that the rejection of claim 11 under 35 U.S.C. § 103 is based on inherency, the rejection is not sound and cannot stand.


Applicants further note their objection to and disagreement with the statements in the Office action to the effect that the presence of an interior void structure is at most an obvious design parameter to the skilled artisan (see, September 12<sup>th</sup> Office action, page 6). To the extent such statements are reiterated in a subsequent Office action on the above-captioned application, Applicants request that the Office action include a basis in fact or technical reasoning in support of such a position.

The claims now pending in the application are in condition for allowance and such action is respectfully requested. The Examiner is invited to telephone the undersigned should a teleconference interview facilitate prosecution of the above-captioned application.

Please charge any additional fees that may be due or credit any overpayment made to Deposit Account No. 501,171.

Respectfully submitted,

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